

Notice of Allowability

Application No.

09/657,986

Examiner

Malgorzata A. Walicka

Applicant(s)

MADISON ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to response of March 16, 2004.
2. ☒ The allowed claim(s) is/are 1,2,6 and 7.
3. ☒ The drawings filed on 30 December 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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The Response under 37 C.F.R. 1.116 and Declaration pursuant to 37 C.F.R. 1.132 filed on March 16, 2004 are acknowledged. Claims 1-2, and 4-7 are pending and are the subject of this Office Action.

OFFICE ACTION

1. Rejections

1.1. 35 USC, section 112, first paragraph

1.1.1. Rejection for lack of written description

The declaration under 37 CFR 1.132 filed March 16, 2004 is sufficient to overcome the rejection of claim 2 based upon insufficiency of disclosure under 35 U.S.C. 112, first paragraph.

2. Examiner's amendment

Please cancel claims 4 and 5.

3. Allowance

Claims 1, 2, 6 and 7 are allowed. The following is a statement of reasons for allowance. Applicants are first to disclose chemical compounds of structure presented by formulas 4 and 6, which are new inhibitors of matriptase. The compound has a potential use in treatment of cancerous conditions, to decrease tumor growth and to retard metastasis.

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In addition, Applicants use these compounds, as well as compounds of formula 1-3, 5, and 7-23 for treating conditions which are ameliorated by inhibiting martiptase or membrane –type serine protease 1 in a mammal in need. The invention is free of prior art and nonobvious. Although structures identified as No.1, 2, 15 and 17 are disclosed in the US patent 5,696,231, structure No. 2 in the US Patents No. 5, 492, 895, structure No. 15 in the US Patent No. 5, 776, 027; and structure No. 17 in the US patent 5,696,231; the patents do not disclose inhibitory effects of the compounds on martiptase or membrane-type serine protease 1.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number is (571) 272-0944 and the right fax number is (571) 273-0944. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m. EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (571) 272-0928. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (703) 308-0196.

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Malgorzata A. Walicka, Ph.D.

Patent Examiner

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PRIMARY EXAMINER
GROUP ~~1800~~
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